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In Re Application of:

Wayne Robinson

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TECHNOLOGY CENTER 2800

Group Art Unit: 2831

Examiner: Chau Nguyen

#8 / Appeal Brief
DEVANS
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Kenny Clamp (Reissue)

APPEAL

Wayne Robinson is the sole inventor in this invention. This application has not been assigned. This is the first and only appeal. There are to applicant's knowledge one related case, that is, the U.S. Patent to Robinson, titled "Kenny Clamp", 5,912,434, wherein this case is a Reissue thereof. There has also been no Declaration of Interference

STATUS OF CLAIMS

Claims 1-7 are allowed, Claims 8-11 are finally rejected under 35 USC 251. Claims 8-11 are also not in proper form.

SUMMARY OF THE INVENTION

The invention is directed to a "Kenny Clamp", whose function is to bond a grounding electrode conductor to the enclosure of a service box or other service equipment, in accordance with the requirements of the National Electric Code. The Code, Article 100, pg 70-29 defines the grounding electrode conductor as the conductor used to connect the grounding electrode to the equipment grounding conductor, to the grounded conductor, or to both, of the circuit at the service equipment or at the source of a separately derived system.

As shown in Fig's 1 and 2 of this application, 1 is the grounding electrode conductor, connected to 2, the grounding electrode, 4 is the panel board of the service equipment and 14 is the press sleeve of copper or aluminum which clamps around the conductor. The essence of this invention is the superior bonding created by clamping the conductor in the sleeve of defined geometrical shape so that good, continuous metallic connections are assured throughout the grounding system. The result of this type of clamp and

7/13/01 similar metal conductors is that in the event of ground fault current, there would be no burn off of the conductor.

ISSUE

Is the rejection of Claims 8-11 under USC 251 as being an improper recapture of broadened subject matter,

surrendered in the application for patent, now U.S. Pat. 5,912,434, a valid rejection?

GROUPING OF CLAIMS

Not applicable.

ARGUMENT

Independent Claim 8 in the Reissue application recites:

b) said enclosure having an inlet in which a metal press sleeve connector can be affixed,

d) said sleeve being in the form of a cylinder having an extension that threads into said inlet of said enclosure, said cylinder having spaced indents, said compression means includes a long handled plier having one toothed arm and another arm having a corresponding groove, said plier grasping said sleeve at said spaced indents to compress said sleeve.

Claim 1 in the Reissue application as well as in U.S. Pat. 5,912,434 recites;

d) said sleeve being in the form of a funnel having a lower bifurcated narrow end and a wider upper end having a cylindrical extension that threads into said inlet said inclosure, said funnel having a threaded exterior surface and said compression means includes a threaded ring having an internal diameter that corresponds to that of said narrow bifurcated end, said ring being rotated so as to compress said bifurcated end of said funnel around said conductor.

While it is true that in the claims of the patent application, a compression means in the form of a long handled plier was claimed, such recitation was recited in association with a metal press sleeve connector and not with the structure of the connector now claimed in Claim 8 or the Reissue application, namely a cylinder.

The Examiner states that Claim 1 of the patent was subsequently allowed because it incorporated in original Claim 1, that the sleeve was in the form of a funnel having a lower bifurcated end and a wider upper end. The Examiner then concludes that since Claim 8 is broader than than patented Claim 1, it is accordingly rejected. The Examiner, as stated above, considers that the Claims 8-11 under 35 USC 251 are an improper recapture of broadened subject matter surrendered in the application for patent.

Applicant traverses this argument and states that this interpretation is a misreading of USC 251, which states:

(See MPEP 1401, Reissue)

Whenever any patent is through error without any deceptive intention, deemed wholly or partly inoperative by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he has a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the

fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application for the unexpired term of the original patent. No new matter shall be introduced in the application for reissue.

Under MPEP 1402 one of the reasons for reissue is, if the applicant believes his claims are too narrow. If one examines the prosecution history including the original claims as well as all the amendments, it will be seen that Claim 8 in the Reissue application, directed to a metal sleeve connector in the form of a cylinder has never been recited in the claims, although that structure is in the specification and the drawings. (See Col. 3 lines 19-36 and Fig's 2 and 3 of the Drawings) No new matter is involved.

To support Examiner's position, *Ball Corp. v. United States*, 221 USPQ 289, 295 was cited. In effect, the Court stated: "The recapture rule bars the patentee from acquiring through reissue, claims that are the same or broader scope than those claims that were canceled from the original application"

Claim 8 and dependent claims 9-11 were never in the original patent application. Ironically, in retrospect, Claims such as original Claim 1 claiming broadly a metal sleeve connector should never have been canceled in view of the prior art. At the time applicant was negotiating with a prospective licensee and was anxious to show the licensee that he was getting a patent. Unfortunately, the negotiations were not successful anyway.

The Examiner also cited *Hester Industries v. Stein*, USPQ2d 1641 and *In Re Clement* 45 USPQ2d 1161.

In *Hester* applicant obtained a patent for a food cooker based on claims that the cooking system cooks solely with steam and that the system includes two sources of steam, nozzles for releasing steam inside said housing, one comprising a steam generator supplying supplemental steam into said housing at said nozzles located therein-side to maintain the atmosphere together with the other steam source at near 100% humidity and at a pressure above atmospheric, and the other source of steam comprising a pool of water within said housing with heating means for boiling the water to create steam. The Examiner rejected all the claims and *Hester* appealed successfully so that the Board allowed his claims and a patent was issued. Subsequently *Hester* filed for two Reissue Patents alleging that the claims were drawn too narrowly on the basis of attorney error. The Reissues were motivated by a competitor, *Stein*, who was in the process of developing a competing cooker. In the Reissue patents cooking solely with steam and two sources of steam were totally absent from the claims.

The court said, "In effect, *Hester*, through eight years of reissue proceedings prosecuted the original application anew, this time placing greater emphasis on aspects previously included in the original claims and removing

limitations repeatedly relied on to distinguish the prior art and described as critical and very material to the patentability of the invention. The realm of corrections within USC 251 does not include recapturing surrendered subject matter without the addition of materially-narrowing limitations."

This case distinguishes from Hester in that the structure allowed in the claim of the patent, namely a connector in the form of a funnel with a bifurcated lower end and a wider upper end was not described as critical and very material to the patentability. In fact, the patent 5,912,434, clearly describes another embodiment namely a connector in the form of a cylinder, a materially narrowing limitation as compared to a metal sleeve connector.

In Clement applicant had obtained a patent directed to process claims for a method, treating a mixture of printed and contaminated waste paper in order to produce a pulp for use in the manufacture of paper and paperboards, said waste paper containing contaminants including stickies,

The court analyzed application of the recapture rule into a series of steps;

1. first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. The court concluded that the board did not err by determining which limitations the Clement deleted from the patent claims.

2. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. In this regard the court looks to the prosecution for arguments and changes to the claims made in an effort to overcome a prior art rejection. Although the recapture rule does not apply in the absence of evidence that the applicant's amendment was not in fact patentable, the court may draw inferences from changes in claim scope when other reliable evidence of applicant's intent is not available.

3. Once it is determined that an applicant has surrendered the canceled or amended claim, it must then be determined whether the surrendered subject matter has crept into the reissue claim. By comparing the reissue claim with the canceled claim, it can be ascertained whether the surrendered subject matter has crept into the reissue claim. If the scope of the reissue claim is the same or broader than that of the canceled claim, then the patentee is clearly attempting to recapture surrendered subject matter, and the reissue claim is therefore unallowable.

4. In summation, the court established the following principles:

- (1) if the reissue claim is as broad or broader than canceled or amended claim in all aspects, the recapture rule bars the claim.

- (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible.

(3) If the reissue claim is broader in some aspects, but narrower in others then (a) if the reissue claim is as broad or broader in an aspect germane to a prior art rejection but narrow in another aspect unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to a prior art rejection and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

By following these steps, it is seen that the surrendered subject matter has not crept into the Reissue claim. For example, the canceled claim 1 recited a metal press sleeve connector. Reissue claim 8 describes the form of the connector as that of a cylinder. This recitation is not recapturing surrendered subject matter, since although such recitation was described in the specification and the drawings, it was never recited in the claims. As indicated in step 2, the recapture rule does not apply, if there is evidence that the original claims were not canceled by virtue of the prior art cited. As stated above, the cancellation of broader claims in the case was made to get a patent as quickly as possible in the hopes of inducing a prospective licensee to sign a contract. Finally this case comes under the category of step 4, paragraph 3 (b) because the reissue claim is narrower in an aspect germane to a prior art rejection..(the recitation of a metal press sleeve connector in the form of a cylinder is narrower than metal press sleeve connector) and is broader in an aspect unrelated to the rejection. (there is no recitation as in original claim 5 or claim 1 of the patent that the compression means includes a threaded ring having an internal diameter corresponding to the threaded exterior surface of the connector.

CONCLUSION

The Examiner states that the narrow scope of the claims was not an error within the meaning of USC 251 and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. The Examiner appears to ignore the fact that MPEP 1402 allows a reissue if it is determined that the applicant's claims are too narrow and there is a basis for allowing broader claims. This is the situation in the present case. It is felt that applicant has a right under USC 251 to amend his claims if there is a basis for doing so in the specification. As pointed out in the argument above, the recitation in claim 8 pertaining to the shape of the metal sleeve connector has never been in the case, nor has the Examiner even considered such form as seen by the prior art cited. Accordingly, a claim of this scope has never been surrendered. The rejection under 35 USC 251 is improper and this case should be passed to issue.

Respectfully Submitted,

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APPENDIX

Claim 8. A device for bonding a grounding electrode conductor to the enclosure of an electric service box in conformance to the National Electric Code comprising:

- a) grounding electrode having a grounding electrode conductor affixed thereto, said conductor extending from said grounding electrode to said enclosure,
- b) said enclosure having an inlet to which a metal press sleeve connector can be affixed, said connector having a top and bottom with an aperture thereat for receiving said conductor, said top of said connector being threaded and secured to said inlet by a locked nut, said conductor having an end that passes through said aperture in said top and being fastened to a bus bar in said enclosure,
- c) compression means for clamping and securing said grounding electrode conductor to said metal said sleeve in electrical contact at the region of clamping,
- d) said sleeve being substantially in the form of a cylinder having an extension that threads into said inlet of said enclosure, said cylinder having spaced indents, said compression means includes a long handle plier having one toothed arm and another arm having a corresponding groove, said plier grasping said sleeve at said spaced indents to compress said sleeve,
- e) said pressed sleeve and said grounding electrode conductor being rated for available fault current.

Claim 9. A device as in Claim 8 wherein said connector and said conductor are made from a metal selected from copper and aluminum.

Claim 10. A device as in Claim 8 wherein said connector and said conductor are adapted for a household or commercial wiring system.

Claim 11. A device as in Claim 8 wherein said sleeve has a diameter of 1/2" or 3/4", said conductor has a dimension within the range of #8-#2 for a 1/2" sleeve and within the range of #1-3/0 for a 3/4" sleeve.

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